

REMARKS

I. Introduction

Claims 9-16 are currently pending in the present application. Claims 9-16 were rejected.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received. Applicants thank the Examiner for considering the information disclosure statement filed on 3/31/06.

III. Rejection of Claims 9-16 Under 35 U.S.C. § 103(a)

Claims 9-16 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,603,183 (“Hoffman”) in view of U.S. Patent No. 6,395,124 (“Oxman”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 9 recites the following:

9. A method for attaching at least one chip in a housing, the housing being optically transparent to radiation of at least one predefined transmission wavelength, the method comprising:

applying an adhesive layer between the at least one chip and the housing; and irradiating the adhesive layer through the housing using radiation of the transmission wavelength for curing.

In support of the rejection, the Examiner contends that: a) “Hoffman discloses . . . a pre-molded plastic housing (102), which is considered to be optically transparent to radiation of at least one predefined transmission wavelength”; b) Hoffman further teaches “an adhesive layer (110) between the at least one chip (108) and the plastic housing (102)”;
c) Oxman teaches “curing the adhesive by UV irradiation through the substrate”; and d) “[i]t would have been obvious . . . that combining Hoffman’s process with Oxman’s teachings would have been beneficial because it helps to cure the adhesive without heating and thus, to prevent degradation or damage to any temperature sensitive component.” Applicants respectfully submit that the overall teachings of Hoffman and Oxman simply would not suggest the asserted combination to one of ordinary skill in the art, for the reasons explained below.

First, with respect to the Examiner’s asserted motivation for making the combination, i.e., “[i]t would have been obvious . . . that combining Hoffman’s process with Oxman’s teachings would have been beneficial because it helps to cure the adhesive without heating and thus, to prevent degradation or damage to any temperature sensitive component,” this rationale is completely contradicted by the explicit disclosure in Hoffman that “optically curable materials 402, 502 entirely cure at elevated temperature, e.g., are heated to reduce the curing time.” (Col. 3, l. 25-27). Since Hoffman explicitly discloses heating the material within the sensor package 100, the teachings of Hoffman explicitly

negates any notion that avoiding heating in order to “prevent degradation or damage to any temperature sensitive component” is an issue of concern to the invention disclosed in Hoffman.

Second, the Examiner’s assertion that “combining Hoffman’s process with Oxman’s teachings would have been beneficial because it helps to cure the adhesive without heating” presupposes that the adhesive 110 disclosed in Hoffman is a type of adhesive that can be cured by irradiation and needs such curing. However, there is absolutely no suggestion in Hoffman that adhesive 110 disclosed in Hoffman can be cured by irradiation, let alone any suggestion that the adhesive needs any curing; in fact, the only information provided in Hoffman regarding the adhesive 110 is that “adhesive 110 [is] sometimes call a die attach adhesive.”

Third, contrary to the Examiner’s contention, there is absolutely no suggestion in Hoffman that substrate 102 is “optically transparent” to radiation of any transmission wavelength. To the extent that the Examiner may be contending that it is theoretically possible that the substrate 102 is optically transparent to radiation of a predefined wavelength, a mere theoretical possibility does not support an inherent disclosure of a claimed element; instead, there must be a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art,” which the Examiner has clearly failed to provide.

For at least the foregoing reasons, claim 9 and its dependent claims 10-13 are allowable over the applied references. Claims 14 and 16 recite features substantially similar to the above-discussed features of claim 9, and therefore claims 14 and 16, as well as dependent claim 15, are similarly allowable over the applied references. Withdrawal of the obviousness rejection of claims 9-16 is requested.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims 9-16 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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